

Application No.: 10/722,619

INTERVIEW SUMMARY

During a brief telephone interview with Examiner Purvis on July 6, 2004, Applicants' attorney, Duane C. Basch, indicated that Applicants do not wish to rely on the previously-submitted Affidavit, as Applicants believe that the Kuno publication date was subsequent to Applicants' earliest priority date claimed in the present application (Application 09/028,790 for a "LABEL FEEDER," filed February 24, 1998 by Peter Davis et al.). Furthermore, Applicants respectfully urge that ample support for pending claims 32 through 44, particularly the description of the pick-and-place assembly system and method of assembly, is found at page 1, line 10 – page 2; line 16; page 5, line 18 – page 6, line 3; and page 12, lines 3 – 19 of the parent application.

Accordingly, Applicants respectfully request that the reasons for allowance of claims 34 – 44 be modified to reflect that the Examiner is not relying on the previously-submitted Affidavit.

REMARKS

The Office Action of March 10, 2003 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Turning now, to the office action, claim 32 was rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,984,176 to Koda et al. ("Koda") in view of US 4,618,392 to Uchimura et al. ("Uchimura") and US 5,540,795 to Franklin et al. ("Franklin"). Claim 33 was objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form to include all limitations of the base and any intervening claims. Claims 34 – 44 were indicated as allowable (see *Interview Summary above*).

Turning now to the rejection of claim 32, the disclosures of the cited art and the distinctions between claim 32 may be briefly summarized as follows:

Koda is directed to a manufacturing method to assure that a bar-coded label with an identification number is applied to an electronic device and the device is further programmed with the number appearing on the label. As noted by the Examiner Koda fails to teach how such a label is applied, and does not teach or suggest that the label is removed for application to a printed circuit board.

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Applicants acknowledge that Uchimura discloses a label feeder with a roller platform, however as noted in Figure 5 "a solenoid (24)" is required (Col. 2, lines 33 and 55) to enable the evacuation of the label from the rollers, even when they are Teflon coated. Furthermore, Uchimura does not teach "initiating of advancement of a tensioned label liner over a separation edge to cause a sequential label to be peeled from the label liner and pushed onto the roller platform.

Franklin is directed to a conveyor belt pad dependent on the assistance of air pressure to "urge the label from the label support means" (Col. 8, line 64) during the label transfer process. Franklin does not recite the use of a plurality of rollers or the parting of the label from the liner by passing over a separating edge. Franklin also does not disclose a label feeder that operates in unison with component feeders. As to the Examiner's statement that Franklin teaches a sensor (95) producing a signal used to start the label producing process, Applicants respectfully maintain that even if the Franklin sensor were to produce such a signal (note that the Examiner admits that this is not taught directly by Franklin, but is at most, implied – see Office Action p. 3, lines 14-16), the teaching does not give rise to the recited step of stopping advancement of the tensioned label liner in response to detecting the presence of a label on the platform. Franklin cannot teach such a limitation as Franklin does not teach a tensioned label liner.

In addition to the above-noted distinctions, and failure to teach or suggest the advancement of a label via a tensioned label liner, or control of such advancement in response to sensing the presence of a label, there is also no suggestion for the proposed combination. It is incumbent, in setting forth a *prima facie* rejection under 35 U.S.C. §103(a) to show where the proposed teaching or suggestion for a combination is found in the cited references. Otherwise, it appears that Applicants' disclosure is being used as a recipe for selecting the appropriate portions of the prior art to construct the claimed invention. A piecemeal reconstruction of the prior art patents in light of the claims is not a basis for a holding of obviousness, *In re Kamm et al.*, 172 USPQ 298 (CCPA, 1972). The mere fact that the prior art devices could have been modified does not make the modification obvious unless the prior art suggested the desirability of such a modification, *In re Gordon*, 221 USPQ 1125, (Fed. Cir., 1984); *Jones v. Hardy*, 220 USPQ 1021, (Fed. Cir. 1984). It is clear that the combination of patents does not suggest that the modifications proposed by the Examiner be made. Furthermore, this combination of references does not disclose a

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tensioned label liner, its advancement over a separation edge to advance a label, nor the control of advancement in response to detection of the label on the platform as set forth in claim 32.

Instead, the Examiner appears to be taking official notice or otherwise suggesting, absent support in the references, that such a combination is obvious "because such control schemes in labeling methods is well known in the prior art. Applicants respectfully request that such "well known" methods be identified in an appropriate reference and that the rejection refer to such a reference. Absent such a basis, *prima facie* obvious has not been established, and the burden is not shifted to Applicants to rebut the rejection.

Considering, *in arguendo*, the combination of Koda in view of Uchimura and Franklin, at most such a combination teaches the use of a platform with rollers to support labels printed by a labeling machine and retrieval of the labels for placement on an electronic device. The arguable combination still would fail to disclose the tensioned label liner, its advancement over a separation edge to advance a label, and the control of advancement in response to detection of the label, as recited in the independent claim. Hence, claim 32 is patentably distinguishable over the arguable combination.

Insofar as claim 33 is concerned, this claim depends from now presumably allowable claim 32 and is also believed to be in allowable condition for the reasons hereinbefore discussed with regard to claim 32.

With respect to the recently-identified patent to Kou, US 6,027,019, Applicants respectfully urge that Kou is directed to monitoring the configuration of component feeders on a placement machine, and that the mention of labels associated with component packages (for placement on feeders and scanning by bar code readers), does not give rise to the invention claimed in the instant application - a teaching of a label feeder for feeding labels for placement, for example by a pick-and-place vacuum head, in an assembly system.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited.